Remarks

Claims 1-8 and 26-27 stand rejected under 35 USC §102, Claims 9-11, 13-15 and 18-25 stand rejected under 35 USC 103(a). Claims 11, 18 and 26 have been amended. Applicants assert that the currently pending claims are now in condition for allowance as set forth more fully below.

102 Rejections

Claims 1-8 and 26-27 stand rejected under 35 § 102(e) as being anticipated by Alperovich et al (US Pat. 6,298,247). Applicants respectfully traverse the rejections. The Office Action rejects independent claim 26 by stating the Alperovich teaches all of its elements. The Office Action goes on to equate the volume controls **(VC1 and VC2)** and the manual volume control *(See Para. 1)* with the two different options for controlling the speaker volume based on ambient noise recited in claim 26. Amended independent claim 26 recites, in pertinent part,

"a method of controlling a speaker volume of a communications device, comprising providing to a user of the communications device at least two different options for automatically controlling the speaker volume based on ambient noise..."

The recited claim explicitly offers the user the choice of one of two *different automatic* methods of volume control of the received signal at the speaker of which only one is chosen. These automatic methods are in addition to any manual volume control that may or may not be present. These recitations are contrary to the teachings of Alperovich.

From the changes reflected in the parenthetical in paragraph 1 of the Office Action, the Office Action appears to concede that Alperovich teaches the use of a single automatic volume control method in that the volume controls VC1 and VC2 *always work together* as a single automatic volume control method. However, the office action then seems to assert that Alperovich's manual volume control is the second volume control option recited in claim 1. Claim 1 has been amended to clarify that the user's selection option is between two **automatic** volume control methods whether or not there is a manual volume control. The existence of a manual control would be a third option albeit not an automatic control option.

6

Thus, Alperovich is not concerned with offering the user the choice of exclusively selecting between two automatic volume control methods to control his listening volume based on an ambient noise level. Accordingly, independent claim 26 recites elements not taught or disclosed in Alperovich and is therefore allowable over Alperovich for at least these reasons. Dependent claims 27 and 1-10 depend from an allowable claim 26 and are also allowable for at least the same reasons.

103 Rejections

Claim 9 stands rejected under 35 USC 103(a) as being unpatentable over Alperovich (US Pat 6,298,247) in view of Higuchi (US Pat. 6,363,344). Claims 10, 11 and 13-15 stand rejected as being unpatentable over Alperovich in view of Clancy (US Pat 5,802,164). Additionally, claims 18-25 were rejected as being unpatentable over Alperovich in view of well known prior art citing The Duplan Corporation v. Deering Miliken (197 USPQ 342). Applicants respectfully traverse these rejections to the extent they apply to the current set of pending claims.

Claim 9

Claim 9 depends from allowable base claim 26 and is also allowable for at least the same reasons. In particular, claim 9 is allowable over the combination of Alperovich and Higuchi because, as discussed above, Alperovich fails to disclose all of the claim recitations including providing at least two different automatic options for controlling the speaker volume based on ambient noise and that corresponds to the option selected by the user and because Higuchi also fails to disclose these same recitations.

Claims 10-11 and 13-15

The Office Action rejects Claims 10-11 and 13-15 by stating that Alperovich teaches all of the claimed elements with the exception of resetting speaker volume to an initial setting at the end of a call which the Office Action asserts is taught by Clancy.

Claim 11 recites, in pertinent part,

"a method of compensating the volume of a speaker of a communications device in response to ambient noise, comprising the steps of:

(a)   selecting an initial volume level for the speaker in the presence of substantially zero ambient noise...

(e)   resetting the volume to the initial volume level upon the call ending and before the establishment of a subsequent call.

First, there is no motivation to combine Clancy and Alperovich. Clancy pertains to the volume of a given channel through a switch and is not linked to any one particular communications device. Furthermore, Clancy deals with enhancement circuitry within a switch or other similarly situated network component and is not concerned with volume control within a particular communications device and is also not concerned with ambient noise at the communications device. Therefore, one of skill in the art of ambient noise reduction through speaker volume control would not be motivated to combine Clancy with Alperovich because Alperovich is concerned with circuitry of the communications device itself while Clancy is concerned with circuitry of a switch in a network.

On page 3, the Office Action states that it rejects claims 10 and 11 for the same reasons. Claim 10 is allowable for at least the same reasons as claim 11 above regarding resetting speaker volume to an initial setting. Furthermore, dependent claim 10 depends from allowable dependent claim 1 and independent claim 26 and is allowable for at least those same reasons proffered under the discussion of the §102 rejections, supra. In particular, claim 10 is allowable over the combination of Alperovich and Clancy because Alperovich fails to disclose all of the claimed recitations including providing at least two different automatic options for controlling the speaker volume based on ambient noise and that correspond to the option selected by the user and because Clancy fails cure these deficiencies of Alperovich.

Since the combination of Alperovich and Clancy fail to teach all the elements of the claims and also fail to provide a motivation to one skilled in the art to modify Alperovich in view of Clancy, claims 10 and 11 are allowable over Alperovich in view of Clancy for at least either of theses reasons. Dependent claims 13 and 15 depend from allowable independent claim 11 and are also allowable for the same reasons.

Claims 18-25

The Office Action rejects Claims 18-25 by stating that although Alperovich fails to teach the determination of a volume level greater than the threshold and providing a

means for receiving user input to activate and deactivate the means for adjusting independently other than powering the device on and off, such teachings are well known in the art. The Office Action further stated that under <u>Duplane v. Deering</u> there is no invention in providing a means to alternate between one unpatentable configuration and another unpatentable configuration where there is no new or different function.

Amended claim 18 recites, in pertinent part,

"a mobile communications device, comprising means for providing at least two user selectable options for automatically adjusting a speaker volume level based on ambient noise...means for resetting the speaker volume level to the initial volume level upon the call ending and before the establishment of a subsequent call and means for receiving user input to activate and deactivate the means for adjusting independently of powering on and off the mobile communications device".

The Office Action Concedes on page 8 that Alperovich does not teach determining greater than threshold and provide means for receiving user input to activate and deactivate the means for adjusting independently of powering on and off the mobile communications device. The Office Action also concedes on page 6 that Alperovich does not disclose resetting the volume to an initial setting. Furthermore, as discussed in regards to the §102 rejections supra, Alperovich fails to teach the use of at least two automatic means for adjusting the speaker volume at the option of the user.

Accordingly, it is true Alperovich suffers from several deficiencies relative to the claim recitations. For instance, the user of the devices disclosed by Alperovich cannot turn the volume control on and off during idle times between calls and during in progress calls. Nor can the users of Alperovich select between multiple automatic methods of automatic volume adjustment.

It is also true that Alperovich offers no implied teaching, suggestion or motivation to provide such an activation/deactivation feature or to provide an alternative volume control method. A reference must provide an explicit or implicit suggestion, teaching or motivation in order to be §103 prior art. *SIBIA Nerosciences, Inc. v. Cadus Pharm. Corp.*, 225 F.3d 1349, 55 U.S.P.Q.2D (BNA) 1927 (Fed. Cir. 2000)(Suggestion or motivation to modify a single reference required for obviousness rejection).

Therefore, for all of the above reasons, Alperovich does not teach all the elements of the claim 18 and claim 18 is allowable over Alperovich in view of <u>Duplan</u> since there is new and different function in a number of elements. Applicants assert that it is not

proper use of official notice without citing a prior reference where the facts asserted are not instantly and unquestionably demonstrated to be well known. MPEP 2144.03, *citing* In Re <u>Zurko</u>, 258 F.3d 1379. Dependent claims 19-25 depend from an allowable claim 18 and are also allowable for at least the same reasons.
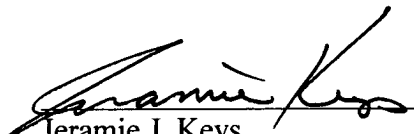
<u>Conclusion</u>

Applicants assert that the application including claims 1-11, 13-15 and 18-27 is in condition for allowance. Applicants request reconsideration in view of the amendments and remarks above and further request that a Notice of Allowability be provided. Should the Examiner have any questions, please contact the undersigned.

No fees are believed due. However, please charge any additional fees or credit any overpayment to Deposit Account No. 50-3025.

Respectfully submitted,

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